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OFFICE OF PETITIONS

IN THE UNITED STATES PATENT  
AND TRADEMARK OFFICE

DOCKET PA1.615

GROUP NUMBER 3732

In re Patent Application of

JOHNSON, GARY E.

Serial No.:09/204,866

Filed: 3 Dec. 1998

For: POWERED CUTTING  
SURFACE WITH PROTECTIVE  
GUARD FOR EQUINE TEETH  
Group: 3732

Examiner: John J. Wilson  
Primary Examiner

I hereby certify that this correspondence  
is being deposited with the United  
States Postal Service as express  
mail in an envelope

ADDRESSED TO:

Assistant Commissioner of Patents  
and Trademarks, Washington,  
D.C. 20231

On 24 March 2003



John E. Halamka

Dated: 24 March 2003

Palos Verdes Estates, California

PETITION TO REVIVE FROM NOTICE OF ABANDONMENT

DATED 1/24/2003

Honorable Assistant Commissioner of Patents and Trademarks  
Washington, D. C. 20231

Dear Honorable Assistant Commissioner of Patents and Trademarks:

Responsive to the Notice of Abandonment dated 1/24/03 for failure to timely file a PROPER reply to an Office letter made FINAL and dated 12 June 2002, Applicant and his attorney had filed a response on 21 December 2002 after inadvertently and unintentionally missing the 12 December 2002 deadline.

In January 2003, upon reading the NOTICE OF ABANDONMENT I was shocked and bitterly disappointed that one of my pending patent applications had become unintentionally abandoned. I looked at the name and was further surprised to see Gary Johnson. There was no way this application could be abandoned after the long hard work expended upon this application. I immediately queried my calendar for Johnson and saw that a response was due 15 March 2003 and was relieved that there must be some mistake that could easily be overcome as I remembered just filing a response in mid December 2002.

Upon examination of the reason for the Notice of Abandonment I was absolutely astounded to find that SOMETHING MUST BE AMISS as

the Response TO FINAL had to be filed within 6 months of the FINAL and I had filed a response on 9/12/02. I was astounded by the thought that the rights of a client may have been extinguished.

I immediately set out to meticulously reconstruct the time line of this file in an effort to determine if I could find a rational reason to petition to reinstate this application.

I had timely responded on 9/12/02 to the FINAL dated 6/12/02 but somehow not to the satisfaction of the Examiner. The reason was not clear. Upon receiving the ADVISORY ACTION dated 10/15/02 (more than 31 days from the filing of my response) I attempted to immediately determine what action to take. However, due to the unavoidable onset of severe eye problem, my ability to complete the analysis of what action to complete and respond completely to the advisory action was impaired and resulted in a delayed filing. This was further complicated by a difficulty in determining any requirement of the examiner to be yet UNFULFILLED. These circumstances caused my filing of 12/22/02 instead of 12/12/02, ten (10) days late.

A copy of this time line is attached hereto and Applicant's Attorney respectfully contends that he has incorporated the concepts in the time line which were imbedded during its construction to remind Applicant's Attorney of any point, argument or provision which should be considered in the Petition to Revive Inadvertently Abandoned Application. If Applicant's Attorney has not successfully incorporated a particular point from the time line, Applicant's Attorney prays that the Commissioner allow applicant's Attorney to amend the Petition with any information the Commissioner believes relevant or file a supplemental to this petition.

What I concluded from the time line exercise of reviewing all of the work in the file was that I had been like a student fighting the question instead of simply answering the quiz. I found that I had developed an attitude. The long time (29 months) between the filing of the application and the first office action had initiated a negative attitude which was extremely unusual for me. This was compounded by not receiving any response to my request for status of this application. I had read the goals of the patent office to decrease the processing time for pending patents. Upon finally receiving an Office Action, I recalled my experience of having to expend considerable effort to refocus my thoughts on the complicated mechanism embodied in this application and how I had reviewed each prior art reference in excruciating detail in order to determine how to advise my client as to contest or accept the rejection of some of the claims. How thrilled I was to determine that no prior art reference including the Hicks reference taught how to support the long shaft of the rotating burr especially under the strong pressure required

when placing the burr against the horse tooth surface including the large molar far back in the horse's mouth. I did find some of the prior art was pertinent, especially as to the finish on the tool which I advised the client had to be accepted without appeal or argument.

In my response to the first office action, I presented my findings to the examiner that the Hicks patent should not be applied as prior art as the long shaft of Hicks is merely placed in a channel without any support or provision to prevent the shaft from coming in contact with the channel other than the teaching to make the channel large to allow "free rotation of the shaft". I attempted to point out that just making a channel large does not provide support but only provides cover.

The Examiner rejected my argument regarding the applicability of Hicks as prior art but only in what Applicant's Attorney respectfully characterizes as an obscure manner on page 4 of the Office action made FINAL that the claims in my client's application did not support my argument. The Office Action made final did not require or even suggest ANY of the claims needed to be modified. The Office Action simply repeated the reasons why the prior art is applicable to reject some of the claims in the application.

In the response to the first Office Action, I had modified claim 2, 3, 7,8,12 & 13 noted to be allowable. I did not file an appeal of the rejected claims even though language in the FINAL shows that the examiner incorrectly believes that elements 19 and 20 of Hicks prior art supports the shaft of Hicks. The Examiner states, "IT IS CLEAR" (emphasis added) they do. It is the other statement of the examiner, "Applicant's remarks as to the manner in which the shaft is supported, are not commensurate with the claim language, therefore, the manner in which the Hicks shaft may behave in use (rubbing against the channel) is given no weight" "which convinced me that filing an appeal may not be productive and the best course of action is to take what is allowed. I believed the allowed claims were in a condition to be allowed as soon as I presented the modifications in the proper format of substitute pages. These allowable claims were noted as allowed in the Office action made FINAL. I believed all was done except to wait for the NOTICE OF ISSUE and pay the issue fee. I was strongly motivated to bring this application to issue so that I would finally have the power on behalf of my client to notify the currently infringing persons to STOP THAT.

Applicant's Attorney respectfully believes he completely and properly responded to the Examiner's stated requirements by filing of the response to the Final, Paper 12, filed 9/12/02.

Applicant's Attorney continued in good faith to research the file and the examiner's requirements in an effort to place the application in a condition for allowance.

In my review of this action I read MPEP Section 706.07(f) which states:

"Applicant should be notified, if certain portions of the amendment would be acceptable as placing some of the claims in better form..."

"...allowable by a telephone call to clear up minor mattes."

I did not receive any call from the examiner.

The intervening onset of a severe eye problem caused the unavoidable or at least unintentional delay in timely responding to the FINAL.

It's been a tough two months since I opened the Notice of Abandonment but my eyes are much better, I've learned a great deal to advance my skills as a Sole Practitioner Patent Attorney:

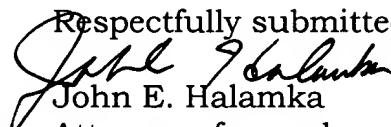
- 1) Pay very close attention to a notice of FINAL action;
- 2) Talk to the Examiner to determine if I am understanding the issue, especially if the outcome is not as expected;
- 3) Seek help; and,
- 4) Keep up with the changes in the rules and regulations especially as to amendment of patent application and how to file in proper format.

As this Petition to REVIVE an Inadvertently Abandoned patent application is filed within the two month statutory period, applicant's attorney believes that no additional fees are due for an extension as no extension beyond the two months is allowed. However, applicant's attorney authorizes any fees found to be due in addition to the Petition Fee believed to be in the sum of \$650.00 for a small entity to be charged to Deposit Account 08-0207.

If the Commissioner determines that a terminal disclaimer is required, Applicant's Attorney further authorizes the payment of any fee which is believed to be \$55 for a small entity for this terminal disclaimer to be charged to Deposit Account 08-0207.

The extension fee of 3 months to file the response to the FINAL action may not have been charged to Applicant's attorney's deposit account and the extension fee may have to be charged for the additional 2 months for this Petition to enter the response making the charge for a fifth month of \$985. If so, attorney authorizes the charge found to be charged to Deposit Account 08-0207.

Timely notice of reinstatement and passage on for allowance of this application is hereby respectfully requested.

Respectfully submitted,  
  
John E. Halamka  
Attorney of record

Time Line for Gary Johnson  
 US Patent Application  
 Serial No. 09/204,866

Paper No.	Date	Remarks
1	12/03/98	Original Filing of Patent Application with informal drawings
2	02/28/98	Official Receipt
?	5/13/01	Request for Status. <u>After over 29 Months</u> from the date of filing and having no response from the Patent Office, Applicant's Attorney filed this paper. No reply was received, presumably because the First Office Action and this request crossed in the mail.
3	03/21/01	<u>First Office Action</u> Rejected claims 1,4,5,9 and 10 - de Estrada in view of Hicks Rejected claim 6 – de Estrada in view of Hicks and further in view of Becker Reject claim 11 – de Estrada in view of Hicks and further in view of Brown Reject claims 14 & 15 – de Estrada in view of Hicks and further in view of Loddeke <b>ALLOWABLE 2, 3, 7,8,12 &amp;13</b> <b>ALLOWED 16-29</b>
4	09/21/01	Response to office action. Applicant's attorney raised the issue of HICKS as not prior art because applicant's shaft support means, item 301, is not shown or even suggested by Hicks or any other of the prior art. Hicks merely shows a channel 23 for the Hick's shaft 15 without any support or means to allow "free rotation of the shaft" other than make sure channel 23 is large to allow the "free rotation of the shaft". If the channel 23 is large, it cannot provide support for the shaft.
5	UNKNOWN	This could have been assigned to the request for status.
6	10/09/01	Notice of Non-Compliance of Amendment as Applicant's attorney did not submit amendments to the claims on substitute pages.
7	11/1/01	Response of SUBSTITUTE PAGES
8	UNKNOWN	

Paper #	Date	Description
9	3/26/02	Notice of Non-Compliance. The SUBSTITUTE PAGES submitted on 11/1/01 do not conform to 37 CFR 1.121(c)(1)(i) as applicant's attorney had not removed the underlining in the claims.
10	4/8/02	Response of NEW SUBSTITUTE Pages in conformance with 37 CFR 1.121(c)(1)(i).
11	6/12/02	<b><u>FINAL.</u></b> Claims 2, 3, 7, 8, 12, 13, and 16-29 Allowed. As in the first Office Action: Claims 1, 4, 5, 9 and 10 rejected over de Estrada in view of Hicks. On page 4 the examiner reviewed Applicant's attorney's "Arguments filed April 17, 2002". This filing, paper 9, was merely substitute pages of the amendments of the claims set forth in paper 4. However, if it is taken as Applicant's Attorney's pointing out that Hick's shaft is unsupported, then the examiners language "IT IS CLEAR (emphasis added) that elements 19 and 20 shown by Hicks support the shaft and therefore meet the claim language." Followed by the Examiner's next statement that "Applicant's remarks as to the manner in which the shaft is supported, are not commensurate with the claim language, therefore, the manner in which the Hicks shaft may behave in use is given no patentable weight." The Shaft support means is set forth in detail in claim 2, formally a dependent claim which is allowable if recast into independent claim. Even though Applicant's Attorney believes the "support means" of claim 1 is fully supported and described in the specification, Applicant's Attorney noted that examiner has his opinion about the "channel" and it may not be practical to further argue this issue with the examiner but take what matter was allowed.

#### WHAT I BELIEVE IS THE ESSESENCE OF THE ISSUE.

Only after intense examination to determine why the examiner stated in paper 13, ADVISORY ACTION, that my response, paper 12, did not place the application in proper order as the claims were not amended, I DID REALIZE THAT THE CLAIMS NEEDED TO BE AMENDED. I began to look for any reason.

The examiner did not expressly require any amendment.

This examination finally disclosed what applicant's attorney respectfully describes as an obscure requirement in paper 11, page 4 wherein the examiner simply states a rejection of applicant's attorney's argument re Hicks because the "remarks as to the manner in which the shaft is supported, are not commensurate with the claim language". Applicant's attorney did not interpret this language as a requirement

that the claims NEEDED TO BE AMENDED. It appeared only as a reason for rejection of the remarks.

**NOT IN USPTO FILE**

In response to the receiving any Office Action I immediately enter response dates into my calendar system with tickler dates. On examination of my calendar system I found:

7/12/02 Entry in Applicant's Attorney's calendar system. "ONE MONTH FROM FINAL OFFICE action on horse tooth application. RESPOND!!!" My client had been out of town and I had not had the opportunity to discuss the status of the application and received any direction from my client on how to respond I placed the status of the application in writing dated 8 Aug 2002. Applicant's Attorney's letter to Applicant. SETTING FORTH SITUATION AND ASKING CLIENT'S DIRECTION – FIGHT OR TAKE WHAT WE HAVE? Because of the FINAL, the response to the rejected claims is limited to APPEAL with possible amendment of claims for appeal, cancellation of claims or file a continuation in part if client has any new matter to be added because of the over 42 Month Pendency of the application from filing to FINAL. THIS DECISION PROCESS TO FORMULATE A RESPONSE TO THE FINAL TOOK A LONG TIME TO ANALYSE.

8/12/02 Tickler Entry in Applicant's Attorney's calendar system. "TWO MONTHS FROM FINAL OFFICE action on horse tooth application. RESPOND!!!"

8/29/02 Tickler Entry in Applicant's Attorney's calendar system. "Two months from mailing of final action on horse tooth application. RESPONSE FROM CLIENT so you can file with PTO?" A reminder that if client has not given direction as of yet that I should contact client again for a decision on how to proceed.

In early September 2002 the applicant called me and instructed me to just take what claims are allowed and not to contest the ones not allowed.

**Back to what is on record with the USPTO**

Paper #	Date	Description
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12	9/12/02	I filed RESPONSE TO FINAL ACTION DATED 6/12/2002.
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In this response thanked the Examiner for the allowed claims and I filed 11 pages of formal drawings along with 4 substitute pages of specification to correct minor errors.

13 10/15/02 **ADVISORY ACTION** that the 9/12/02 does not place application in order. AS IS MY PRACTICE UPON RECEIVING AN OFFICE ACTION I PLACED AN ENTRY INTO MY CALANDER THAT 1/15/03 would be last day to respond without fee to this office action after a cursory reading that a response is due in 3 months.

**NOT OF RECORD in the USPTO**

I examined my calendar system and did find an entry for 1/15/03 that this was the last day to respond without extension fee to an office action for Gary Johnson.

I also found another entry in my calendar system for 3/15/03 that a response was due to an Office Action for Gary Johnson.

**FIRST OVERSIGHT.** The ADVISORY ACTION notice actually required a response within 3 months of the date of Final rejection which applicant's attorney failed to read and note.

**SECOND OVERSIGHT,** I ALLOWED MY OWN INTENSE REACTION TO THIS ADVISORY ACTION TO CLOUD MY BELIEF THAT I DID NOT HAVE THE URGENCY TO RESPOND. I IMPROPERLY INTERPRETED IT AS JUST ANOTHER REJECTION OF MY ARGUMENT ON HICKS WITH TIME TO ANALYSE AND FORMULATE AN ARGUMENT TO CONVINCE THE EXAMINER THAT HICKS WAS NOT PROPERLY PRIOR ART. **ONLY**

**AFTER RECEIPT OF THE NOTICE OF ABANDONMENT DID  
APPLICANT'S ATTORNEY DETERMINE;**

SOMEWHERE IN THE CORRESPONDENCE FROM THE EXAMINER, APPLCANT'S ATTORNEY WAS REQUIRED TO AMEND THE CLAIMS.

Further, this office action was mailed to my old office address so picked up around end of October. (CHANGE OF ADDRESS?)

11/08/02 Noticed large number of floaters, shadows and impairment of vision

11/12/02 **ONSET OF SEVERLY IMPARED EYE SIGHT** by noticeable dimming of optic field of vision.

11/15/02 Appointment with optometrist. Failed peripheral eye test.

11/19/02 Entry in Applicant's Attorney's calendar for Applicant – Review file and verify entry of date of response to latest office action. As the dimming of the field of vision had not improved, Applicant's Attorney did not CAREFULLY read or examine intensely said ADVISORY ACTION to determine what was the issue and the proper time for response.

11/22/02 Doheney eye exam by Ophthalmologist. Found that the vitreous sack of eye had separated from the retina but did not cause any retinal tearing. The Doctor determined that there was no action to take but wait for the body to remove the blood that had seeped into the eye which will clear up the floaters and wait for the sack to reattach to which will remove the shadows.

By the second week in December Applicant's Attorney's eyes began to heal and the vision clear.

UNFORTIONATLY THIS WAS AFTER 12/12/02 - SIX MONTHS AFTER FINAL

01/25/03 Follow up eye appointment.

Had to reschedule this appointment for February as our son announced that he had accepted an invitation to give the keynote speech to the Medical Informatics Convention in San Diego 25-26 January 2003.

02/14/03 Rescheduled appointment cancelled by the Doctor and Rescheduled a second time for 21 March 2003.

I had anticipated responding to the NOTICE of ABANDONMENT much before the last day of 3/24/03 and did not wish to reschedule the appointment a third time so I kept the appointment and anticipated being back to the office to finalize my work on the PETITION to REVIVE.

03/21/03 The appointment TOOK ALL DAY with dilatation of my eyes for a complete examination of the retina and examination for glaucoma. The Retinal exam showed that the eyes are healing but the glaucoma exam resulted in a prescription for drops to assist in reducing the intraocular pressure.

#### **Back on record of PTO**

Paper #	Date	Description
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#? 12/22/02 Even though my official calendar indicated no action was required I wanted to clear this item from my mental calendar. Therefore I initiated working on the response to ADVISORY ACTION and determined possible amendment to the claims by Applicant's attorney in a determinedly focused effort to comply with the examiner's requirement to amend the claims in a form acceptable to the examiner. Applicant respectfully requests the response filed 12/22/02 be admitted for the file

and examined by the Commissioner to determine Applicant's Attorney's efforts. This amendment focuses on Claim 12 which Applicant's Attorney did not believe required amendment, WAS NOTED AS ALLOWED BY THE EXAMINER, but could be what the examiner believes needed to be amended.

ONLY AFTER THE EFFORT OF DETERMINING THIS TIME LINE DID APPLICANT'S ATTORNEY COME ACROSS ANOTHER CLUE. AND ONLY IN CONJUNCTION WITH THE EXAMINATION OF A FILE WRAPPER FOR ANOTHER CLIENT DID APPLICANT'S ATTORNEY REALIZE IN RESPONSE TO FINAL, THE APPLICANT SHOULD WITHDRAW THOSE CLAIMS NOT ALLOWED. In applicant's attorney's almost 20 year practice before the US Patent and Trademark Office, Applicant's Attorney NEVER WITHDREW a claim and applicant's attorney respectfully alleges the concept of WITHDRAWAL of a claim was just not it his repertory when responding to office actions.

Applicant's attorney has operated under his understanding of "Patent Rule 1.113(a) Final rejection or action" whereupon applicant's reply is limited to APPEAL in the case of rejection of any claim or to amendment.

Applicant directed Applicant's attorney to simply take the claims which have been allowed. This is what applicant's attorney attempted to do in paper 12 and respectfully contends that nothing further is required.

After receiving Paper 13 Applicant's Attorney was extremely disappointed that yet another response is YET AGAIN being required and was EXTREMELY MOTIVATED to respond to bring the application to a condition for allowance as applicant was experiencing infringement of his device by others. I wanted the patent to issue so that I could contact the infringer and tell them to STOP THAT!

In view of the inability of Applicant's Attorney to respond to the Examiner in a manner which placed the application in condition for allowance, extreme effort was expended from 24 January to 20 March 2003 in determining how to petition to revive an inadvertently abandoned application.

Applicant's Attorney acknowledges the obligation to comply with the rules of the US Patent and Trademark Office and has taken courses, subscribes to publications which point out practice and procedure changes but applicant's attorney did not know that POSSIBLY what the examiner was trying to communicate was that the applicant had not withdrawn the claims which were rejected and thus found not allowed.

Applicant's attorney respectfully contends that had he known he would certainly have WITHDRAWN CLAIMS 1, 4, 5, 6, 9, 10, 11, 14, and 15 to place the application in an acceptable state to proceed to issue.

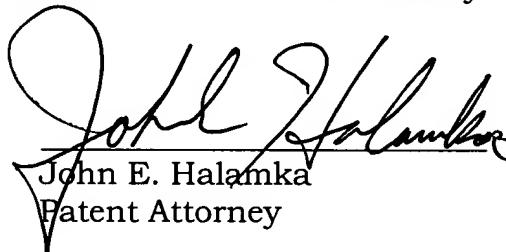
Applicant's attorney hereby requests said claims now be allowed to be withdrawn.

#? 1/24/03 Notice of Abandonment.

#? 3/24/03 PETITION TO REVIVE filed by U.S. Express mail

I, John E. Halamka, attorney of record and licensed to practice before the United States Patent and Trademark Office do hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Signed 3/24/03 at Palos Verdes Estates California in the County of Los Angeles.



John E. Halamka  
Patent Attorney